UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,760	07/05/2005	Hideyuki Kobayashi	036910-0114	7036

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EXAMINER
MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/534,760	KOBAYASHI ET AL.
	Examiner	Art Unit	
	Naghmeh Mehrpour	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 March 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   **Claims 1-6, 8-22,** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thornton (US patent 6,851,454) in view of Marshall (US Publication 2003/0233278).

Regarding claim 1, Thornton teaches a charging method for use in a service providing system

having a first terminal device owned by a user and (b) a service providing server, connected to

the first terminal device via a communication network, offering an information providing service

to the first terminal device (see figure 2), the method comprising:

(1) a step of a service providing server transmitting, to the first terminal device,

a modification command for modifying a predetermined parameter determining an

operation of the first terminal device (col 7 lines 9-28);

(1I) a step of the first terminal device modifying the predetermined parameter

only when the first terminal device receives the modification command for modifying

the predetermined parameter from the service providing server (col 7 lines 9-28); and

Thornton fails to teach a step of the service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter. However, Marshall teaches a step of the service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter (0037). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 2, Thornton teaches a method as set forth in claim 1, wherein:
upon receipt of a request for modifying the predetermined parameter from the
user, the service providing server transmits, to the first terminal device owned by the
user, the modification command for modifying the predetermined parameter in
accordance with a content of the received request (col 6 lines 10-22, col 7 lines 9-28, col 9 lines 1-21).

Regarding claim 3, Thornton inherently teaches a method as set forth in claim 2, wherein:
a second terminal device which is different from the first terminal device is
owned by the user, the second terminal device being connected to the service

providing server via a communication network (see figure 2); and

the request for modifying the predetermined parameter to the service providing

server is made by the user by means of the second terminal device (col 6 lines 10-22, col 7 lines

9-28 col 9 lines 1-21). When the user is able to use the first device, he will be able to use the

second device as well.

Regarding claim 4, Thornton fails to teach a method wherein in offering a service of providing

information to the first terminal device, the service providing server charges the user owning the

first terminal device a fee for the service offered. However, Marshall teaches a method wherein

in offering a service of providing information to the first terminal device, the service providing

server charges the user owning the first terminal device a fee for the service offered (0037).

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was

made to combine the above teaching of Marshall with Thornton, in order to provide a system for

altering behavior in a variety of applications such as the status of the events.

Regarding claim 5, Thornton fails to teach a method comprising:

(1V) a step of the service providing server, when the first terminal device

owned by the user transmits certain information to the service providing server,

rewarding the user with one or more points, the points varying in number depending

on information received; and

(V) a step of the service providing server using at least one of the points owned by the user for

settlement of the charge to the user. However, Marshall teaches a method comprising:

(1V) a step of the service providing server, when the first terminal device

owned by the user transmits certain information to the service providing server,

rewarding the user with one or more points, the points varying in number depending

on information received (0097); and

(V) a step of the service providing server using at least one of the points owned by the user for

settlement of the charge to the user (0097). Therefore, it would have been obvious to ordinary

skill in the art at the time the invention was made to combine the above teaching of Marshall

with Thornton, in order to provide a system for altering behavior in a variety of applications such

as the status of the events.

Regarding claim 6, Thornton fails to teach a method as set forth in the first terminal device is an

in-vehicle terminal device provided in an automobile owned by the user, and the predetermined

parameter is a parameter determining an operation of the in-vehicle terminal device in a vehicle-

antitheft system. However, Marshall teaches a method as set forth in the first terminal device is

an in-vehicle terminal device provided in an automobile owned by the user, and the

predetermined parameter is a parameter determining an operation of the in-vehicle terminal

device in a vehicle-antitheft system (0116). Therefore, it would have been obvious to ordinary

skill in the art at the time the invention was made to combine the above teaching of Marshall

with Thornton, in order to provide a system for altering behavior in a variety of applications such

as the status of the events.

Regarding claim 8, Thornton teaches a service providing server for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 9, Thornton inherently teaches a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 10, Thornton inherently teaches a storage medium storing a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 11, Thornton inherently teaches a terminal device for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 12, Thornton teaches a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11.

Regarding claim 13, Thornton teaches a recording medium containing a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11.

Regarding claim 14, Thornton teaches a control method of a service providing server being

connected to a first terminal device and a second terminal device via a communication network,

the service providing server offering an information providing service with respect to the first

terminal device (col 6 lines 10-22) (col 9 lines 1-21) When the user is able to use the first device,

he will be able to use the second device as well, the method comprising:

(1) a modification request accepting step of receiving a modification request from the second

terminal device, the modification request requesting to transmit, to the first terminal device, a

modification command for modifying a predetermined parameter determining an operation of the

first terminal device (col 7 lines 9-28); and

a modification command transmitting step of generating the modification command in

accordance with the modification request, and then transmitting the modification command to

the first terminal device (col 7 lines 1-21).

Regarding claim 15, Thornton inherently teaches a method as set forth in claim 14, further

comprising:

a validity judging step of judging whether or not the modification request

received from the second terminal device is valid (col 8 lines 5-20, col 9 lines 8-21).

Regarding claim 16, Thornton inherently teaches a method as set forth in claim 15, wherein: the

first terminal device has a plurality of the parameter, the parameter being

settable on a parameter-by-parameter basis, and

in the step (11I), it is judged whether the modification request received from the

second terminal device is valid with reference to a combination-table specifying, in

advance, whether or not each combination of the parameters of the first terminal

device is permitted (col 9 lines 8-21). The confirmation message, confirm the validity of the

request.

Regarding claim 17, Thornton inherently teaches a method as set forth in claim 14, further

comprising:

(IV) history recording step of storing, in a history information database, a content of a parameter

setting when transmitting the modification command to the first terminal device (col 10 lines 27-

40). Most system usually have a backup for recording the history of any action in the system.

Regarding claim 18, Thornton teaches a method as set forth in claim 17, further comprising the

step of :

(V) a setting restoration step of generating a modification command for change back a parameter

into a previous state in accordance with the history information database, and then transmitting

the generated modification command to the first terminal device (col 5 lines 10-63, col 6 lines

22-32) the server instruct the WCD to change from voice mode to data mode and change back to

voice mode.

Regarding claim 19, Thornton inherently teaches a service providing server executing the control

method of a service providing server, as set forth in claim 14 (col 9 lines 1-21).

Regarding claim 20, Thornton inherently teaches a service providing program for causing a

computer to execute the control method of a service providing server, as set forth in claim 14

(col 9 lines 1-20).

Regarding claim 21, Thornton teaches a storage medium containing a service providing program

for causing a computer to execute the control method of a service providing server, as set forth in

claim 14 (col 9 lines 1-21, lines 60-65, col 10 lines 27-40).

Regarding claim 22, Thornton inherently teaches a service providing system, comprising:

the service providing server as set forth in claim 14, and

through terminal device and a second terminal device, each of which being connected to the

service providing server via a communication network (see figure 2). When the user is able to

use the first device, he will be able to use the second device as well.

3.   **Claim 7**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton (US

patent 6,851,454) in view of Breed (US Publication 2005/0046584).

Regarding claim 7, Thorton fails to teach a method as set forth in claim 6, wherein:

reporting action to be carried out when a sensor provided in the automobile detects an abnormal

situation. However, Breed teaches a method as set forth in claim 6, wherein:

reporting action to be carried out when a sensor provided in the automobile detects an abnormal

situation (1275). Therefore, it would have been obvious to ordinary skill in the art at the time the

invention was made to combine the above teaching of Breed with Thornton, in order to provide a

system for altering behavior in a variety of applications such as the status of the events.

Response to Arguments

4.   Applicant's arguments with respect to claims 1-22 have been considered but are moot in

view of the new ground(s) of rejection.

        In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Thornton fails to teach a method wherein in offering a service of providing

information to the first terminal device, the service providing server charges the user owning the

first terminal device a fee for the service offered. However, Marshall teaches a method wherein

in offering a service of providing information to the first terminal device, the service providing

server charges the user owning the first terminal device a fee for the service offered (0037).

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was

made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Conclusion

5.   **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.
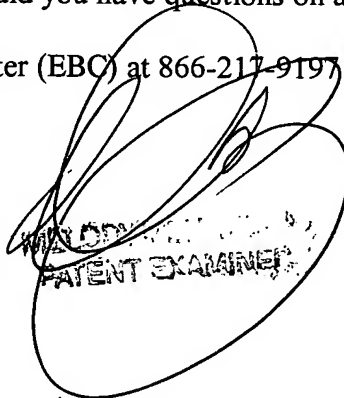
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

October 24, 2006